

US Serial No. 09/737,908

Attorney Docket No. C059-03 US

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REMARKS**Amendments to the Claims**

Claims 3-33 were pending in the present application. Claims 3, 8, and 27 have been amended. Claim 31 has been canceled.

Claims 3 and 27 have been amended to correct grammatical errors. Claim 8 has been amended to make the claim more clear. Support for amended claim 8 can be found in original claims 3 and 8 and throughout the specification.

Accordingly, upon entry of this amendment claims 3-30 and 32-33 will be pending in the application. None of the amendments introduces new matter.

Provisional Obviousness-Type Double Patenting Rejection

Claim 3 stands provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of co-pending United States patent application 11/121851.

Applicants will address compliance with 37 C.F.R. §§ 1.321(b) and (c) if and when the claims in the instant application are allowable.

Rejections under 35 U.S.C. § 112, first paragraph

Claim 31 is rejected under 35 U.S.C. § 112, first paragraph. Claim 31 has been canceled. Accordingly, applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 112, first paragraph.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 3, 8, 27, and 31 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to point out and distinctly claim the subject matter which the applicant regards as the invention. Claim 31 has been canceled.

The Office Action states that claim 3 contains a grammatical error in the phrase "a halo substituents." Applicants have amended the claim to correct this error. The Office Action also states that the word "selected" appears to be out of place. Applicants respectfully disagree. Applicants draw the Examiner's attention to page 8, line 31 through page 9, line 2, where a "selected substituted alkyl" is defined as "an alkyl radical in which (a) one proton is replaced by a group selected from hydroxyl, carboxy C₁-C₃

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alkoxy, unsubstituted amino, acylamino, or acylamino phenyl or (b) one to three protons is replaced by a halo substituent.

The Office Action states that claim 8 recites that R^1 can be $-NH-CH_2-R^{12}$, and that R^{12} can be unsubstituted alkyl. The Office Action goes on to say that this is a contradiction with claim 3 to which claim 8 depends because claim 3 recites that when R^1 is $NH-A'$, substituent variable A' cannot be C_4-C_{14} unsubstituted alkyl. The Office Action asks the question "Which limitation controls"? The question of which limitation controls is answered in 37 C.F.R. 1.75(c) which states:

Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

Therefore, it is quite clear that by defining R^{12} to include alkyl groups, those alkyl groups must, by reference to claim 3, be other than C_3-C_{13} alkyl, in order to satisfy the limitation of claim 3. In the interest of furthering prosecution, however, Applicants have added this limitation to amended claim 8.

Claim 27 is rejected due to a missing preposition. Claim 8 has been amended to add the missing preposition.

Accordingly, for the foregoing reasons, applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

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CONCLUSION

For the reasons presented above, Applicants respectfully request reconsideration and prompt allowance of all pending claims. A Petition for Extension of Time is enclosed. Please deduct the fee of \$510 for the Petition and apply any other charges or credits to Deposit Account No. 50-1986, referencing attorney docket number C059-03 US.

Respectfully submitted,

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